UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,668	03/15/2001	Yasuhiro Terayama	7217/64043	5414

7590	05/18/2005

JAY H. MAIOLI
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER
LE, MIRANDA

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/809,668	TERAYAMA ET AL.
	Examiner	Art Unit	
	Miranda Le	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04 March 2005</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-3 and 5-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-3 and 5-32</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   **Office Action Summary**   Part of Paper No./Mail Date 050205

DETAILED ACTION

1.   This communication is responsive to Amendment, filed 03/04/2005.

2.   Claims 1-32 are pending in this application. Claims 1, 12, 22, 24 are independent claims.

In the Amendment, claims 1, 12, 22, 24 have been amended, claim 4 has been cancelled, no

claims have been added. This action is made Final.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4.   Claims 1-3, 5-10, 12-19, 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Lection et al. (US Patent No. 6,765,596 B2), in view of Sorge et al. (US Patent No.

6,691,281 B1), and further in view of Teshima (US Patent No. 6,750,830).

   As per claim 1, Lection teaches a step of determining whether the data indicated by the

detected identifier is displayable on the limited-capability device (i.e. which tasks have

information to display to the user, col. 3, lines 1-3);

a step of displaying on the display unit the extracted data for display the data to be shaped

for display on the limited capability device (i.e. a graphical selection area may be provided on

the task view for a selected task where this selection area may be activated by the user to return

to the multi-function application launcher view, col. 3, line 31-34);

Lection does not expressly teach the following claimed limitations. However, Sorge

teaches:

a step of determining what characteristic of the first file is to be converted (i.e. ID is

associated with the data, col. 3, line 63 to col. 4, line 21, col. 7, lines 19-21);

a step of detecting the identifier by reading the file (i.e. indicating a beginning and the

end of the translated data inserted, col. 4, lines 25-27, col. 5, line 44 to col. 6, line 37, col. 10,

lines 17-44);

a step of extracting the data, the start and the end of which are indicated by the

determined identifier and which is determined to be displayable on the limited-capability device

(i.e. the application program preferably inserts tags into the HTML document, indicating a

beginning and end of the translated data inserted, and indicating functional elements of the data,

col. 4, lines 25-28, col. 8, line 45 to col. 9, line 5, col. 5, line 44 to col. 6, line 37);

a step of outputting an output file which is newly created from the extracted data that has

been shaped in the step of shaping, as a different file from the first file, to the limited-capability

device for display (i.e. the user desires to republish the logic flows to a block 20, which retrieves

the selected HTML document, col. 8, lines 46-48, col. 12, line 41 to col. 13, line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Sorge's teachings the steps of determining what

characteristic of the first file is to be converted, detecting the identifier by reading the file, extracting the data..., outputting an output file..." would have allowed Lection's users to export data into hypertext markup language (HTML) documents, and to update a previously exported discreet data section in an HTML document without changing any other section of the HTML document while ensuring that such data can be imported from the HTML document back into a source application with all the formatting unique to the source application intact.

Lection, Sorge do not expressly teach the following claimed limitations. However, Teshima teaches:

a step of reading out stored processing condition data having shaping conditions including character count per line and image size limitations (i.e. start image Information representation read out of the user information, col. 14, lines 13-27, col. 10, lines 31-54).

a step of shaping, based on the read-out processing condition data, the extracted data to meet the limitations for display on the limited capability device (i.e. the alignment includes left justification, centering and right justification, col. 11, lines 13-15, col. 10, line 53 to col. 11, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references because Teshima's teachings the steps of determining what characteristic of the first file is to be converted, detecting the identifier by reading the file, extracting the data..., outputting an output file... would have allowed Lection's users to display the edit image having a desired layout and suitable format for their devices.

As per claim 12, Lection teaches detector means for detecting the identifier

corresponding to the selected characteristic that indicates the data to be displayed on the

limited-capability device from the first file stored in said first file storage means (col. 3, line 35

to col. 4, line 28);

output means for outputting the extracted data to the limited-capability device, whereby

the limited-capability device displays on a screen thereof one of the map, the coupon and the

address information (col. 3, line 35 to col. 4, line 28, Fig. 1);

wherein the extracted data is one of a map, a coupon, and address information in Fig. 1.

Lection does not explicitly teach the following claimed limitations, but Sorge teaches:

extractor means for extracting, from said first file, the data with the start and the end

thereof indicated, in accordance with the identifier detected by the detector means (i.e. the

application program preferably inserts tags into the HTML document, indicating a beginning and

end of the translated data inserted, and indicating functional elements of the data, col. 4, lines 25-

28, col. 8, line 45 to col. 9, line 5, col. 5, line 44 to col. 6, line 37);

means for selecting a characteristic of the first file that is to be converted (col. 3, line 63

to col. 4, line 21, col. 7, lines 19-62);

file storage means for storing the first file (col. 5, line 44 to col. 6, line 37);

control means for controlling the detector means to detect the identifier indicating the

start and the end of the displayable data for the purpose of extracting the data displayable on the

limited-capability device from said first file stored in said file storage means based on stored

processing condition data having shaping conditions (col. 4, lines 25-28, col. 8, line 45 to col. 9,

line 5), for controlling said extractor means to extract, as a new output file with the selected

characteristic having been converted, data including the start and the end indicated by the

identifier from said first file (i.e. the application program preferably inserts tags into the HTML

document, indicating a beginning and end of the translated data inserted, and indicating

functional elements of the data, col. 4, lines 25-28, col. 8, line 45 to col. 9, line 5, col. 5, line 44

to col. 6, line 37), and for controlling said output means to output the new output file to the

limited-capability device for display (i.e. the user desires to republish the logic flows to a block

20, which retrieves the selected HTML document, col. 8, lines 46-48, col. 12, line 41 to col. 13,

line 40).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Sorge's teachings of extractor means for extracting,

from said first file, the data with the start and the end thereof indicated, in accordance with the

identifier detected by the detector means; means for selecting a characteristic of the first file that

is to be converted; file storage means for storing the file; and control means for controlling

detector... would have allowed Lection's users to export data into hypertext markup language

(HTML) documents, and to update a previously exported discreet data section in an HTML

document without changing any other section of the HTML document while ensuring that such

data can be imported from the HTML document back into a source application with all the

formatting unique to the source application intact.

Lection, Sorge do not expressly teach "control means for controlling...based on stored

processing condition data having shaping conditions". However, Teshima teaches this limitation

at col. 14, lines 13-27, col. 10, lines 31-54.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references because Teshima's teachings control means for controlling...based on stored processing condition data having shaping conditions would have enabled Lection's users to display the edit image having a desired layout and suitable format for their devices.

As per claim 22, Lection teaches a step of displaying the data stored in the first buffer to be shaped for the limited capability device (i.e. a graphical selection area may be provided on the task view for a selected task where this selection area may be activated by the user to return to the multi-function application launcher view, col. 3, line 31-34, col. 3, line 35 to col. 4, line 28);

Lection does not specifically teach the following claimed limitations. However, Sorge teaches:

a step of determining what characteristic of the first file is to be converted (col. 3, line 63 to col. 4, line 21, col. 7, lines 19-62);

a step of initializing a first data buffer for buffering data when a plurality of pieces of data is read from the file (col. 8, line 45 to col. 9, line 5);

a step of detecting the identifier indicating the start of the data in the file, based on a rule for processing the data in the file into a data format displayable on the limited capability device, when the data is from the file and is stored in the first data buffer (i.e. the application program preferably inserts tags into the HTML document, indicating a beginning and end of the translated data inserted, and indicating functional elements of the data, col. 4, lines 25-28, col. 8, line 45 to col. 9, line 5, col. 5, line 44 to col. 6, line 37);

a step of moving the data stored in the first data buffer to a second data buffer for

evacuation; and a step of moving the data evacuated into the second data buffer to the first data

buffer for restoration (col. 8, line 45 to col. 9, line 5, col. 9, line 52 to col. 10, line 44, col. 12,

line 41 to col. 13, line 40).

a step of holding the data in the file, from the start thereof, into the first data buffer, based

on the identifier indicating the start of the detected data (col. 8, line 45 to col. 9, line 5, col. 9,

line 52 to col. 10, line 44);

a step of detecting the identifier indicating the end of the data in response to the identifier

indicating the end of the detected data (i.e. the application program preferably inserts tags into

the HTML document, indicating a beginning and end of the translated data inserted, and

indicating functional elements of the data, col. 4, lines 25-28, col. 8, line 45 to col. 9, line 5, col.

5, line 44 to col. 6, line 37)

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Sorge's teachings the herein above claimed limitations

would have allowed Lection's users to export data into hypertext markup language (HTML)

documents, and to update a previously exported discreet data section in an HTML document

without changing any other section of the HTML document while ensuring that such data can be

imported from the HTML document back into a source application with all the formatting unique

to the source application intact.

Lection, Sorge do not expressly teach the following claimed limitations. However,

Teshima teaches:

a step of reading out stored processing condition data having shaping conditions including character count per line and image size limitations (i.e. start image Information representation read out of the user information, col. 14, lines 13-27, col. 10, lines 31-54).

a step of shaping, based on the read-out processing condition data, the extracted data to meet the limitations for display on the limited capability device (i.e. the alignment includes left justification, centering and right justification, col. 11, lines 13-15, col. 10, line 53 to col. 11, line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references because Teshima's teachings the steps of determining what characteristic of the first file is to be converted, detecting the identifier by reading the file, extracting the data..., outputting an output file... would have enabled Lection's users to display the edit image having a desired layout and suitable format for their devices.

As per claim 24, Lection teaches a detector means for detecting an identifier which indicates the data, which is processable by the second apparatus, from the file stored in the storage means (col. 3, line 35 to col. 4, line 28);

the extracted data is one of a map, a coupon, and address information in Fig. 1 (i.e. People Search-119);

wherein the second apparatus comprises: a receiver means for receiving the data output by the first apparatus (col. 4, line 58 to col. 5, line 29);

a display means for displaying on a limited-capability display the data received by the receiver means (col. 3, line 35 to col. 4, line 28).

Lection does not expressly teach the following claimed limitations. However,

Sorge teaches:

wherein the first apparatus comprises: means for selecting a characteristic of the first file

that is to be converted (col. 7, lines 19-62, col. 3, line 63 to col. 4, line 21);

a storage means for: storing the first file (col. 14, line 42 to col. 15, line 10);

an extractor means for extracting, from the input file, the data which is detected by the

detector means and is processed into data processable by the second apparatus (col. 5, line 44, to

col. 6, line 37, col. 8, line 45 to col. 9, line 5);

a processing means for processing the extracted data into the data that is processable by

the second apparatus (col. 14, line 42 to col. 15, line 28, col. 12, line 41 to col. 13, line 39);

an output means for outputting the data, which has been processed to be processable by

the second apparatus, to the second apparatus (col. 12, line 41 to col. 13, line 39);

control means for controlling the storage means to store the file input thereto in the

storage means, for controlling the detector means to detect the identifier that indicates, from the

file stored in the storage means, data that can be processed to be processable by the second

apparatus (col. 4, lines 25-28, col. 8, line 45 to col. 9, line 5),

for controlling the extractor means to extract the data that is processed by the processing means

in accordance with the identifier detected by the detector means, and for controlling the output

means to output the data that has been processed by the processing means based on the selected

characteristic (col. 4, lines 25-28, col. 8, line 45 to col. 9, line 5, col. 5, line 44 to col. 6, line 37).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Sorge's teachings of all the addressed claimed

limitations herein above would have allowed Lection's users to export data into hypertext

markup language (HTML) documents, and to update a previously exported discreet data section

in an HTML document without changing any other section of the HTML document while

ensuring that such data can be imported from the HTML document back into a source

application with all the formatting unique to the source application intact.

As per claim 2, Lection teaches the step of extracting the data is performed by

referencing a processing condition data area of a memory file that defines the identifier of the

data that is displayable on the limited-capability device (col. 3, line 58 to col. 4, line 28).

Sorge teaches this limitation at col. 12, line 41 to col. 13, line 39.

As per claim 3, Lection teaches the processing condition data area includes a conversion

rule for converting an image data file, and further comprising a step of outputting, to the

limited-capability device, the image data file that has been converted based on the conversion

rule of the image data file (col. 3, line 58 to col. 4, line 28).

Sorge teaches this limitation at col. 12, line 41 to col. 13, line 39, col. 5, lines 28-44.

As per claim 5, Teshima teaches the processing condition data area has a data structure

containing a plurality of categories, and wherein the file conversion method further comprises

selecting the processing condition data to be used, based on the category selected from among

the plurality of categories (col. 5, lines 16-44).

As per claim 6, Sorge teaches a file name of a file output as the different file uses a

symbol string indicated by the predetermined identifier (i.e. Rename New File, Step 144, Fig. 4).

As per claim 7, Lection teaches a step of selecting a file to be output to the

limited-capability device from among the extracted data in response to an instruction from a user

(col. 3, line 35 to col. 4, line 28).

Sorge teaches this limitation at col. 8, lines 46-48 (i.e. publish).

As per claim 8, Sorge teaches a step of acquiring the first file through a communication

network from a data storage apparatus (col. 16, lines 1-22).

As per claim 9, Sorge teaches the step of extracting the data comprises initializing a data

buffer (col. 15, line 29 to col. 16, line 23, col. 8, line 45 to col. 9, line 5),

and buffering in the data buffer the data included in the first file, the start and the end of

which are indicated by the detected identifiers (col. 15, line 29 to col. 16, line 23, col. 8, line 45

to col. 9, line 5).

As per claim 10, Lection teaches the outputting of the data, the start and the end of

which are indicated by the identifiers, to the limited-capability device is restricted in accordance

with the identifiers (col. 6, line 30 to col. 7, line 14).

Sorge teaches this limitation at col. 5, line 44 to col. 6, line 67, col. 8, line 45 to col. 9,

line 5.

As per claim 13, Lection teaches an extracted data storage means for storing the

extracted data as candidate data to be output to the limited-capability device (col. 3, line 35 to

col. 4, line 28).

Sorge teaches this limitation at col. 12, line 41 to col. 13, line 39.

As per claim 14, Lection teaches the data converter selectively outputs the data from

among data stored in said extracted data storage means to the limited capability device in

response to an instruction of a user (col. 3, line 35 to col. 4, line 28).

Sorge teaches this limitation at col. 5, line 44 to col. 6, line 21.

As per claim 15, Lection teaches an image converter means for converting an image file

indicated by said first file using said stored processing condition data into data for display on the

limited-capability device (col. 3, line 35 to col. 4, line 28).

Sorge teaches this limitation at col. 5, lines 28-44, col. 12, line 41 to col. 13, line 39.

Teshima teaches this limitation at col. 14, lines 13-27, col. 10, lines 31-54).

As per claim 16, Lection teaches a rule file storage means for storing a conversion rule

file for converting said image file into an image file displayable on the limited-capability device,

wherein said image converter means performs image conversion based on data indicating a

screen size of the limited-capability device included in said conversion rule file (col. 3, line 35 to

col. 4, line 28).

Sorge teaches this limitation at col. 5, lines 28-44, col. 12, line 41 to col. 13, line 39.

Teshima teaches this limitation at col. 14, lines 13-27, col. 10, lines 31-54).

As per claim 17, Lection teaches a display data output means for converting said first file

into a data format displayable on the limited-capability device for displaying said first file,

wherein the data converter acquires a file which is converted to be output to the

limited-capability device from a file buffer means which buffers at least one file of the display

data output means (col. 3, line 35 to col. 4, line 28).

Sorge teaches this limitation at col. 5, lines 28-44, col. 12, line 41 to col. 13, line 39, col.

8, line 45 to col. 9, line 5.

As per claim 18, Lection teaches a data communication means for acquiring the file

through a communication network (col. 10, lines 38-49).

Sorge teaches this limitation at col. 15, line 29 to col. 16, line 22.

As per claim 19, Lection teaches the data converter restricts, to the limited-capability

device, the outputting of data not displayable on the limited-capability device, from among data

from the start to the end indicated by the extracted identifier (col. 6, line 30 to col. 7, line 14).

Sorge teaches this limitation at col. 5, line 44 to col. 6, line 67.

As per claim 23, Sorge teaches a step of storing, in a storage means, data from the first

data buffer as data to be processed (col. 8, line 45 to col. 9, line 5);

a step of moving the data evacuated into the second data buffer to the first data buffer for

restoration (col. 9, line 52 to col. 10, line 44).

As per claim 25, Lection teaches the first apparatus further comprises a receiver means, and wherein the receiver means receives the file from a file server connected to the receiver means via a network (col. 4, line 58 to col. 5, line 29).

Sorge teaches this limitation at col. 14, line 42 to col. 15, line 28.

As per claim 26, Sorge teaches a buffer means for buffering the data extracted from the file by the control means, and wherein the control means controls the buffer means to buffer the extracted data while processing the data buffered in the buffer means (col. 8, line 45 to col. 9, line 5).

As per claim 27, Sorge teaches the first apparatus further comprises an operation means operated by a user (col. 14, line 42 to col. 15, line 28),

wherein the control means outputs the data, designated on the operation means by the user, to the second apparatus (col. 14, line 42 to col. 15, line 28).

As per claim 28, Sorge teaches an operation means operated by a user (col. 14, line 42 to col. 15, line 28);

a storage means for storing the data received by the receiver means (col. 6, line 39 to col. 7, line 18, col. 14, line 42 to col. 15, line 28),

wherein the data designated on the operation means by the user is read from the storage means and is displayed on the display means (col. 10, lines 17-44, col. 14, line 42 to col. 15, line 28).

As to claims 29-32, Sorge teaches the step of determining what characteristic determines

one of an image size and a file format and a character count (col. 7, lines 19-62).

Teshima teaches this limitation at col. 14, lines 13-27, col. 10, lines 31-54).

5.   Claims 11, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lection

et al. (US Patent No. 6,765,596 B2), in view of Sorge et al. (US Patent No. 6,691,281 B1), and

further in view of Serbinis et al. (US Patent No. 6,584,466 B1).

As per claim 11, Lection teaches "the start and the end of which are indicated by the

identifiers, is indicated by the identifiers" at col. 3, line 35 to col. 4, line 2; Sorge also teaches

this limitation at col. 5, line 44 to col. 6, line 67.   However, Lection, Sorge, Teshima do not

specifically teach "the expiration date of the data".   However, Serbinis teaches this limitation at

col. 9, lines 21-33.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Serbinis's teaching of the expiration date of the data

would have provided Lection's users a plurality of document management services, including

document storage and retrieval, collaborative file sharing and workflow services for electronic

documents, an electronic document delivery service, and a document distribution service.

/   **As per claim 20,** although Lection, Sorge, Teshima do not explicitly teach "an expiration

date extractor means for extracting, from the identifier, expiration date data indicating the

expiration date of the data extracted by the identifier; and an expiration date determination means

for determining the expiration date of the extracted data based on the expiration date of the

extracted data", Serbinis teaches this limitation at col. 9, lines 21-33.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Serbinis's teaching of an expiration date extractor means

for extracting, from the identifier, expiration date data indicating the expiration date of the data

extracted by the identifier; and an expiration date determination means for determining the

expiration date of the extracted data based on the expiration date of the extracted data would

have provided Lection's users a plurality of document management services, including document

storage and retrieval, collaborative file sharing and workflow services for electronic documents,

an electronic document delivery service, and a document distribution service.

As per claim 21, Lection, Sorge, Teshima do not specifically teach a data renewal means

for renewing the expiration date of the extracted data when it is determined that the extracted

data has expired. Serbinis, however, teaches this limitation at col. 9, lines 21-33.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to combine the cited references because Serbinis's teaching of a data renewal means for

renewing the expiration date of the extracted data when it is determined that the extracted data

has expired would have allowed Lection's users to utilize the common document management

services of a server, while presenting she/he with distinct dedicated websites.

Response to Arguments

6.   Applicant's arguments filed 03/04/2005 have been fully considered but they are not

persuasive.

Applicant argues that:

(a) There is no suggestion in either reference of any benefits to be had by making the

combination of selected portions of the two references.

(b) Sorge does not teach shaping conditions that include character count per line and

image size limitations.

The Examiner respectfully disagrees for the following reasons:

Per (a), first, in response to applicant's argument that Lection does not even relate to the

same problem being solved by the present invention, a recitation of the intended use of the

claimed invention must result in a structural difference between the claimed invention and the

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior

art structure is capable of performing the intended use, then it meets the claim. In a claim drawn

to a process of making, the intended use must result in a manipulative difference as compared to

the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312

F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). As Applicant indicated in Remarks on page

14, lines 10-18, the present invention is intended to permit the use of a limited capability device

to display information typically displayed on a nonlimited capability device", and "The limited

capability device can be a cell phone or a personal digital assistant (PDA) and the desired

information may be web page information"; similarly, Lection is related to "methods for

improving interactions with users of pervasive computing devices such as <u>personal digital

assistants, Web-enabled cellular phones</u>; and a multifunctional application launcher is defined

that is <u>specifically adapted for use on devices with limited display space</u>" (Abstract).

The knowledge that is within the level of one of ordinary skill is highlighted hereinabove

for the Applicant's convenience. The Examiner believes that the Applicants have failed to

determine the level of ordinary skill as taught by Lection.

Second, although Lection teaches the steps of determining whether the data is

displayable; and displaying the data on the limited capability device; Lection does not expressly

teach the steps of determining what characteristic of the first file to be converted; detecting the

identifier by reading the file; extracting the data, the start and the end of which are indicated by

the determined id; outputting an output file which is newly created from the extracted data.

Sorge teaches these limitations as addressed in the rejection above.

Sorge is analogously related to a file conversion method for exporting (extracting) data

into hypertext markup language (HTML) documents. Since Lection's devices includes PDAs,

Web-enabled cellular phones, Web appliances, it would have been obvious to one of ordinary

skill in the art to modify Lection's teachings by utilizing all the Sorge's teachings as indicated

above. Such modification would enable users of Lection's system to retrieve and display

documents or data generated by word processing or spreadsheet applications that converted into

an appropriate HTML compatible format (Sorge, col. 1, lines 60-65).

Therefore, in response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992).

Further, in response to applicant's arguments against the references individually, it is

reminded that one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Per (b), Applicant's arguments regarding the cited references do not teach the amended

limitations such as shaping conditions that include character count per line and image size

limitations with respect to claims 1, 12, 22, 24 have been considered but are moot in view of the

new ground(s) of rejection.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.
      If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (571) 272-4107. The fax number to this Art Unit is (703) 872-9306.

      Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.
      Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Miranda Le
May 12, 2005